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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,059	06/25/2001	Tatsuya Chino	109825	6583
25944	7590	11/04/2005		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER KIM, NICHOLAS J	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/887,059

Applicant(s)

CHINO ET AL.

Examiner

Nicholas Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 25 June 2001.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Specification***

1. The disclosure is objected to because of the following informalities: "PHS" should be expanded in the first instance to read "Personal Handyphone (PHS)." Appropriate correction is required.

### ***Claim Objections***

2. Claims 1, 12, and 15 are objected to because of the following informalities: "selecting at least one of the displays" at line 7 of Claim 1, line 7 of Claim 12, and line 5 of Claim 15 should read "selecting at least one of the plurality of displays." Appropriate correction is required.
3. Claims 19 and 22 are objected to under 37 CFR § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims or rewrite the claims in independent form. Claims 19 and 22, both reciting a computer program, refer to independent method Claims 12 and 14, respectively, but are classified in a separate statutory class. Further, Claims 19 and 22 fail the "Infringement Test" for dependent claims. (See MPEP § 608.01 (n). The test for a proper dependent claim is whether the dependent claim includes every limitation of the parent claim. The test is not whether the claims differ in scope. A proper dependent claim shall not conceivably be infringed by anything

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which would not also infringe the base claim). Mere possession of a computer program that, if executed, causes a computer to perform the steps recited in Claims 12 or 14 constitutes infringement of dependent Claims 19 or 22, respectively. However, infringement of independent Claims 12 and 14 would not also occur by the mere possession of such program. Accordingly, Claims 19 and 22 are not in proper dependent form.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. In particular, Claims 1, 3, 6, 9, 12, 14, 15, 18, 21, and 25 recite the limitation “the display” at lines 11, 3-5, 9, 3-5, 11, 3-5, 9, 3-5, 2-4, and 2-4, respectively. It is unclear to which of previously recited plurality of displays these limitation corresponds. Accordingly, for the purpose of expediting examination, “the display” is interpreted to mean “the selected of the plurality of displays.”

7. Additionally, Claims 4 and 10 recite the limitation "the distribution information" at lines 2 of each Claim. There is insufficient antecedent basis for these limitations in the claims.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 19-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In particular, Claims 19-25, directed to a computer program, are computer listings per se, i.e., the descriptions or expressions of the programs, and are neither computer components nor statutory processes, as they are not "acts" being performed.

10. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process. When considering the invention defined by Claims 19-25 as a whole, these Claims are directed to a computer program without the computer-readable medium needed to realize the computer program's functionality. Therefore, Claims 19-25 are non-statutory functional descriptive material. MPEP at § 2106(IV)(B)(I)(a).

### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-25 are rejected under 35 U.S.C. 102(e) as anticipated by Cohen (U.S. Patent No. 6,236,330).

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13. Beginning with Claims 1, 12 and 19, Cohen teaches a terminal location information collecting step (Col. 4, l. 9-12 ) for collecting a location information of a mobile terminal (“controller 16”), a display selecting step (Col. 1, l. 65-66, “within a predefined geographic zone”) for selecting at least one of the displays (Col. 1, l. 61-62, “one or more billboard display panels”) based on the location information of the mobile terminal collected by the terminal location information collector, and an information distribution step (Col. 1, l. 66 – Col. 2, l. 1, “drives the display to generate a message”) for distributing the desired information answering the request information (Col. 1, l. 2-5, “displayed pursuant to...” ) on the display selected in the display selecting step. In an alternate interpretation of Cohen, it is noted that the controller 16 of Cohen corresponds to a display 14, thereby inherently selecting or designating the corresponding display (FIG. 4).

14. Cohen also teaches all limitations of Applicants’ Claims 2, 13, and 20, including a location information storing step (Col. 5, l. 15-1, “exact location ... periodically downloaded”) for storing the location information of the mobile terminal collected in the terminal location information collecting step.

15. Concerning Claims 3, 14, and 21, Cohen discloses a display location information collecting step (Col. 5, l. 15, “exact location”) for collecting a location information of the display, wherein the display is selected in the display selecting step based on the location information of the display collected by the display location information collecting step (Col. 5, l. 58-61, “most proximate”).

16. Additionally, Cohen describes a distribution information storage (Col. 5, l. 33-35) for storing the distribution information in order to distribute the desired information in response to

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the request information, wherein an identification information (Col. 5, ℓ. 20-30, “advertiser billing”) corresponding to the desired information is stored in the distribution information storage, thereby anticipating Applicants’ Claims 4 and 5.

17. With regard to Claims 6 and 15, Cohen teaches a display selecting step (Col. 5, ℓ. 62 – Col. 6, ℓ. 2) for selecting at least one of the displays based on a display designation information contained in the request information, and an information distribution step (Col. 1, ℓ. 66 – Col. 2, ℓ. 1, controller drives display) for distributing the desired information answering the request information to the display selected in the display selecting step.

18. Further, Cohen discloses Applicants’ Claims 7-8 and 16-17, including a terminal location information collecting step (Col. 4, ℓ. 9-12) for collecting a location information of the mobile terminal, and a location information storing step (Col. 5, ℓ. 15-16) for storing the location information of the mobile terminal collected in the terminal location information collecting step.

19. Addressing now Claims 9 and 18, Cohen teaches a display location information collecting step (Col. 5, ℓ. 15-16) for collecting a location information of the display, wherein the display is selected in the display selecting step based on the location information of the display collected by the display location information collecting step (Col. 5, ℓ. 58-61).

20. Cohen also discloses all limitations recited in Claims 10 and 11, including a distribution information storage (Col. 5, ℓ. 33-35) for storing the distribution information in order to distribute the desired information in response to the request information, wherein an identification information (Col. 5, ℓ. 20-30, “advertiser billing”) corresponding to the desired information is stored in the distribution information storage.

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21. Turning to Claims 22-25, Cohen describes a display location information collecting step (Col. 5, l. 15) for collecting a location information of the display, wherein the display is selected in the display selecting step based on the location information of the display collected by the display location information collecting step (Col. 5, l. 58-61 ). Cohen also teaches collecting a location information of the mobile terminal (Col. 4, l. 9-12), storing the location information of the mobile terminal (Col. 5, l. 15-16) collected in the terminal location information collecting step, and collecting a location information of the display (Col. 5, l. 15), wherein the display is selected in the display selecting step based on the location information of the display collected by the display location information collecting step (Col. 5, l. 58-61). It is noted that Claim 25 recites limitations corresponding substantially to limitations already recited in Claim 14 (from which Claim 22 depends).

### ***Conclusion***

22. The prior art made of record and not relied upon is considered pertinent to Applicants' disclosure. Alewine et al. (U.S. Patent No. 6,564,143) describes locating and collecting location information of a mobile terminal, selecting a display based on mobile terminal/display location information and display designation, and distributing desired information answer request information. Tryding (U.S. Patent No. 5,880,732) discloses enabling the usage of a remote display monitor for presenting display data from a mobile telephone. Lehtinen et al. (U.S. Patent No. 6,172,673) describes a multimedia terminal including a receiver (such as a LCD) and a digital telephone apparatus. Erekson (U.S. Patent No. 6,622,018) describes controlling remote devices over a wireless connection. Abowd et al. (Abowd, Gregory D., Christopher G. Atkeson,



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Jason Hong, Sue Long, Rob Kooper, and Mike Pinkerton, "Cyberguide: A Mobile Context-Aware Tour Guide," Wireless Networks, Vol. 3, 1997, p. 421-433) discloses a hand-held mobile context-aware guide including GPS for tourists. Marriott (Marriott, Michel, "Handheld Device Is More Than Guide," New York Times, June 22, 2000, p. G.7) and Parker (Parker, Lonnae O'Neal, "Museum Tours iGo interactive," Tampa Tribune, Jul 20, 1997, p. 4) describe two examples of location/context-aware portable museum guides, MEG and iGo.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Kim whose telephone number is (571) 272-1392. The examiner can normally be reached on Monday - Friday 8am - 4:30pm.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NJK

  
JEFFREY D. CARLSON  
PRIMARY EXAMINER